APPEAL BRIEF UNDER 37 C.F.R. § 41.37

TABLE OF CONTENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant(s):	Alex Dai-Shun Poon	Examiner:	Sanjeev Malhotra
Serial No.:	09/491,703	Group Art Unit:	3667
Filed:	January 26, 2000	Docket No.:	2043.007US1
Customer No.:	49845	Confirmation No.:	8953
Title:	METHOD AND APPARATUS FOR FACILITATING USER SELECTION OF A CATEGORY ITEM IN A TRANSACTION		

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Mail Stop Appeal Brief- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

      This Appeal Brief is presented in response to the Notice of Panel Decision from Pre-Appeal Brief Review dated October 31, 2012, and further in support of the Notice of Appeal to the Board of Patent Appeals and Interferences, filed on October 1, 2012, from the Final Rejection of claims 9, 14-16, 25, 30-32, 41, 46-48, 71, 73 and 75 of the above-identified application, as set forth in the Final Office Action mailed on June 29, 2012.

      The Commissioner of Patents and Trademarks is hereby authorized to charge Deposit Account No. 19-0743 in the amount of $630.00 which represents the requisite fee set forth in 37 C.F.R. § 41.20(b)(2). The Appellant respectfully requests consideration and reversal of the Examiner's rejections of the pending claims.

1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent application is the assignee, eBay Inc.

2. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant that will have a bearing on the Board's decision in the present appeal.

3. STATUS OF THE CLAIMS

Claims 1-8, 10-13, 17-24, 26-29, 33-40, 42-45, 49-70, 72, 74, and 76 are canceled. Claims 9, 14-16, 25, 30-42, 41, 46-48, 71, 73, and 75 are twice-rejected, still pending, and the subject of this Appeal.

4. STATUS OF AMENDMENTS

Subsequent to the Final Office Action dated June 29, 2012 (hereinafter "*Office Action*"), Appellant submitted amendments to claim 9 (to remove an extraneous recitation of "being") and claim 75 (to remove an extraneous period). In the Advisory action dated October 3, 2012 (hereinafter "*Advisory Action*"), the Examiner stated "OK to Enter AF Claim Amendments."[1]

---

[1] *Advisory Action* at 2.

5. SUMMARY OF CLAIMED SUBJECT MATTER

As illustrated, described, and claimed in the present application, aspects of the present inventive subject matter include, but are not limited to, a method and apparatus for facilitating user selection of a category item in a transaction.[2]

INDEPENDENT CLAIM 9

9.   A method comprising:

providing a plurality of category entries to be displayed in a display window (page 56, lines 26-36; page 57, lines 1-7; FIG. 7), said plurality of category entries being indicative of a categorization of a plurality of items that are available to be included in a computerized transaction (page 56, lines 15-16);

detecting a selection of a category entry of said plurality of category entries in said display window (page 57, lines 26-28; FIG. 4, reference numeral 430; page 59, lines 1-5; FIG. 5, reference numeral 550);

in response to said detection of said selection of said category entry, providing a plurality of subcategory entries to be displayed in said display window, said plurality of subcategory entries being further indicative of said categorization of said plurality of items (page 57, lines 27-28; page 58, lines 1-5; FIG. 4, reference numeral 440; page 59, lines 7-10; FIG. 5, reference numeral 560);

detecting a selection of a subcategory entry of said plurality of subcategory entries in said display window (page 58, lines 3-6; FIG. 4, reference numeral 450; page 59, lines 11-13; FIG. 5, reference numeral 570);

receiving a specification of a category number that uniquely identifies a combination of said category entry and said subcategory entry (page 58, lines 8-10; FIG. 4, reference numeral 470);

receiving an additional specification of said category number (page 57, lines 19-22; FIG. 4, reference numeral 420; page 58, lines 21-24; FIG. 5, reference numeral 520); and

---

[2] Appellants note that all figure numbers, reference characters, reference numerals, page numbers, and line numbers are made in reference to Appellants' as-filed patent application. Line numbers are counted from the beginning of the page.

based on said receiving of said additional specification of said category number automatically reselecting said category and said subcategory in said display window (page 57, lines 22-25; FIG. 4; page 58, lines 24-28; FIG. 5, reference numeral 535).

INDEPENDENT CLAIM 25

25.   A computer readable medium containing executable instructions which, when executed in a processing system, cause said system to perform a method, said method comprising:

providing a plurality of category entries to be displayed in a display window (page 56, lines 26-36; page 57, lines 1-7; FIG. 7), said plurality of category entries being indicative of a categorization of a plurality of item items that are available to be included in a computerized transaction (page 56, lines 15-16);

detecting a selection of a category entry of said plurality of category entries in said display window (page 58, lines 3-6; FIG. 4, reference numeral 450; page 59, lines 11-13; FIG. 5, reference numeral 570);

in response to said detection of said selection of said category entry, providing a plurality of subcategory entries to be displayed in said display window, said plurality of subcategory entries being further indicative of said categorization of said plurality of items (page 57, lines 27-28; page 58, lines 1-5; FIG. 4, reference numeral 440; page 59, lines 7-10; FIG. 5, reference numeral 560);

detecting a selection of a subcategory entry of said plurality of subcategory entries in said display window (page 58, lines 3-6; FIG. 4, reference numeral 450; page 59, lines 11-13; FIG. 5, reference numeral 570);

receiving a specification of a category number that uniquely identifies a combination of said category entry and said subcategory entry (page 58, lines 8-10; FIG. 4, reference numeral 470);;

receiving an additional specification of said category number (page 57, lines 19-22; FIG. 4, reference numeral 420; page 58, lines 21-24; FIG. 5, reference numeral 520); and

based on said receiving of said additional specification of said category number automatically reselecting said category and said subcategory in said display window (page 57, lines 22-25; FIG. 4; page 58, lines 24-28; FIG. 5, reference numeral 535).

INDEPENDENT CLAIM 41

41.   An article of manufacture comprising a program storage medium readable by a computer and tangibly embodying at least one program of instructions executable by said computer to perform a method, said method-comprising:

providing a plurality of category entries to be displayed in a display window (page 56, lines 26-36; page 57, lines 1-7; FIG. 7), said plurality of category entries being indicative of a categorization of a plurality of item items that are available to be included in a computerized transaction (page 56, lines 15-16);

detecting a selection of a category entry of said plurality of category entries in said display window (page 58, lines 3-6; FIG. 4, reference numeral 450; page 59, lines 11-13; FIG. 5, reference numeral 570);

in response to said detection of said selection of said category entry, providing a plurality of subcategory entries to be displayed in said display window, said plurality of subcategory entries being further indicative of said categorization of said plurality of items (page 57, lines 27-28; page 58, lines 1-5; FIG. 4, reference numeral 440; page 59, lines 7-10; FIG. 5, reference numeral 560);

detecting a selection of a subcategory entry of said plurality of subcategory entries in said display window (page 58, lines 3-6; FIG. 4, reference numeral 450; page 59, lines 11-13; FIG. 5, reference numeral 570);

receiving a specification of a category number that uniquely identifies a combination of said category entry and said subcategory entry (page 58, lines 8-10; FIG. 4, reference numeral 470);

receiving an additional specification of said category number (page 57, lines 19-22; FIG. 4, reference numeral 420; page 58, lines 21-24; FIG. 5, reference numeral 520); and

based on said receiving of said additional specification of said category number automatically reselecting said category and said subcategory in said display window (page 57, lines 22-25; FIG. 4; page 58, lines 24-28; FIG. 5, reference numeral 535).

This Summary of Claimed Subject Matter is provided with citations to specific locations in the specification and figures of the present application. Due to the specificity of these citations, as should be readily understood, full understanding of the subject matter of the citations may require the context of the surrounding paragraphs and figure elements. Further, this summary does not provide an exhaustive or exclusive view of the present subject matter, and Appellants refer to each of the claims and its legal equivalents for a complete statement of the invention.

6. ARGUMENT

A) *The Applicable Law under 35 U.S.C. §103(a)*

As the Supreme Court stated in *KSR Int'l Co. v. Teleflex Inc.*,[3] the factual inquiries announced in *Graham v. John Deere*[4] (scope and content of the prior art; differences between the claimed invention and the prior art; level of ordinary skill in the art; and secondary indicia of non-obviousness), remain the foundation of any determination of obviousness.[5] It remains true that "[t]he determination of obviousness is dependent on the facts of each case."[6]

Furthermore, "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention."[7]

B) *Discussion of the rejection of independent claims 9, 25, and 41 under 35 U.S.C. § 103(a) as allegedly being unpatentable in view of U.S. Patent No. 6,397,221 issued to* Greef *et al. and* Official Notice

The Examiner rejected claims 9, 14, 15, 25, 30, 31, 41, 46 and 47 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,397,221 issued to Greef et al. (hereinafter "*Greef*") in view of Official Notice taken by the Examiner that allegedly teaches or suggests an action that occurs "for a transaction to take place."[8]

---

[3] *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).
[4] *Graham v. John Deere*, 383 U.S. 1, 17–18 (1966).
[5] *See* Examination Guidelines Update: Developments in the Obviousness Inquiry After KSR v. Teleflex, Federal Register / Vol. 75, No. 169 / Wednesday, September 1, 2010 / Notices, p. 53644 (hereinafter "2010 KSR Guidelines").
[6] *Sanofi-Synthelabo v. Apotex, Inc.*, 550 F.3d 1075, 1089 (Fed. Cir. 2008) (citing Graham, 383 U.S. at 17–18 (1966)).
[7] *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984); *see also* MPEP section 2141.02.IV.
[8] *Office Action* at 3-4.

---

1. Greef *does not teach or suggest all of the elements of the independent claims*

Each of independent claims 9, 25, and 41 recites, in part,

> provid[ing] a plurality of category entries to be displayed in a display window, said plurality of category entries being indicative of a categorization of a plurality of items that are available to be included in a computerized transaction;

> detect[ing] a selection of a category entry of said plurality of category entries in said display window;

> in response to said detection of said selection of said category entry, provid[ing] a plurality of subcategory entries to be displayed in said display window, said plurality of subcategory entries being further indicative of said categorization of said plurality of items;

> detect[ing] a selection of a subcategory entry of said plurality of subcategory entries in said display window;

> receiv[ing] a specification of a category number that uniquely identifies a combination of said category entry and said subcategory entry;

> receiv[ing] an additional specification of said category number; and

> based on said receiving of said additional specification of said category number automatically reselect[ing] said category and said subcategory in said display window.

Although *Greef* discusses a database that is "hierarchically arranged and presented" as "an alternative to relational databases"[9] and that a "record identifier could be, for example, the tabular attribute model number, the model number for the product being an identifier likely to receive recognition across presentation formats,"[10] *Greef* does not teach or suggest the elements of each of independent claims 9, 25, and 41 recited above as asserted by the Examiner. The Official Notice taken by the Examiner does not cure this deficiency.

For example, *Greef* does not teach or suggest "receiving a specification of a category number that uniquely identifies a combination of [a] category entry and [a] subcategory entry," much less "receiving an additional specification of said category number," and "based on said

---

[9] *Greef* at col. 2, lines 61-67 and col. 3, lines 1-6.
[10] *Greef* at col. 18, lines 42-46).

receiving of said additional specification of said category number automatically reselecting said category and said subcategory in said display window," as recited in each of independent claims 9, 25, and 41. Instead, *Greef* merely discusses "enabl[ing] the user to select a tabular product attribute to act as general identifier for products in the hierarchical frame structure."[11] As an example of one such tabular attribute, *Greef* discusses a "model number."[12] However, *Greef* does not teach or suggest that the "model number" (or any such tabular attribute for a product) "uniquely identifies a combination of a category entry and a subcategory entry, much less "receiving a specification of [said] category number" and "automatically reselecting said category and said subcategory in [a] display window . . . based on [a] receiving of an additional specification of said category number," as recited in each of independent claims 9, 25, and 41.

2. Greef *teaches away from the elements of the independent claims*

Greef explicitly disparages the idea of using predetermined keywords or numbers to access a product record:

> Typically, product names, model numbers or other form of designators are disposed, in rows as record identifiers, followed by columns of product features; i.e., product attributes, which define the product, or vice versa, i.e., columns of product names and rows of attributes. *As will be appreciated, to access a product record, commonly, either the user has to designate a product name, model number, or enter a descriptive, product-feature word strings to locate the product desired. However, such record access procedures are difficult for shoppers who don't know what model names or numbers to ask for, or who don't understand what features will be appropriate to put in a string search, or indeed, who don't really know what they are exactly looking for, And, as might be expected, this problem becomes even more difficult where the shopper spectrum includes individuals having different levels of product awareness, and diverse ages, educational, and community backgrounds.* As will be appreciated, the less sophisticated the shoppers, the more difficult it is for them to appreciate the search process, understand product jargon, and discriminate between product features.[13]

---

[11] *Greef* at col. 18, lines 40-42.
[12] *Greef* at col. 18, lines 44-46.
[13] *Greef* at col. 2, lines 40-60 (emphasis added).

Thus, *Greef* teaches away from, at least, "receiving a specification of a category number that uniquely identifies a combination of said category entry and said subcategory entry, "receiving an additional specification of said category number," and "based on said receiving of said additional specification of said category number automatically reselecting said category and said subcategory in said display window," as recited in each of independent claims 9, 25, and 41, because, for example, such operations would introduce similar difficulties for shoppers as discussed in *Greef*.

Furthermore, it would not have been obvious to one skilled in the art at the time of Applicants' invention to perform the operations recited in each of independent claims 9, 25, and 41 given the above discussion in *Greef*. For example, the keywords or numbers discussed in *Greef* do not teach or suggest a "category number that uniquely identifies a combination of [a] category entry and [a] subcategory entry," as recited in each of independent claims 9, 25, and 41. As another example, the discussion in *Greef* of accessing a product record by keywords or numbers does not teach or suggest "automatically reselecting [a] category and [a] subcategory in a display window," much less doing so "based on a receiving of an additional specification of said category number," as recited in each of independent claims 9, 25, and 41.

3. The Official Notice *taken by the Examiner does not cure the deficiencies of* Greef

The Examiner conceded that "*Greef* might not expressly disclose a transaction."[14] The Examiner then stated that "since this is an e-commerce shopping system and method, a transaction is obviously present" and "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to have a transaction take place per the Official Notice . . . because such a modification would allow *Greef* to have items to select from, prior to making a transaction."[15] However, even if a transaction is obvious in view of *Greef*, which Appellant does not admit, no combination of *Greef* and the Official Notice teaches or suggests the elements of each of claims 9, 25, and 41 discussed above.

---

[14] *Office Action* at 6.
[15] *Office Action* at 6-7.

---

4. *U.S. Patent Application Publication No. 2005/0071251 A1 to Linden et al., which was improperly introduced by the Examiner in the* Office Action, *also does not cure the deficiencies of* Greef

The Examiner appeared to rely on a combination of *Greef* and U.S. Patent Application Publication No. 2005/0071251 A1 to Linden et al (hereinafter "*Linden*") as allegedly teaching or suggesting various elements of independent claims 9, 25, and 41.[16] However, reliance on a combination of references not cited on the Examiner's rejection of independent claims 9, 25, and 41 renders the finality of the *Office Action* improper.[17] Here, the Examiner rejected independent claims 9, 25, and 41 as allegedly being unpatentable under *Greef* in view of Official Notice.[18] The Examiner did not reject independent claims 9, 25, and 41 as being unpatentable under *Greef* in view of *Linden*. Thus, the Examiner appears to have introduced a new ground for rejection that was not necessitated by Appellant amendments.

Furthermore, *Linden* does not teach or suggest any of the elements of independent claims 9, 25, and 41 discussed above that *Greef* and the Official Notice do not teach or suggest. *Linden* is directed to "monitoring user browsing activities that indicate user interests in particular products, or other items, represented in an electronic catalog, and for using such information to identify items that are related to one another."[19] To that end, *Linden* discusses that "The various product offerings are arranged within a browse tree in which each node represents a category or subcategory of product."[20] However, like *Greef* and the Official Notice, *Linden* does not teach or suggest, at least, "receiving a specification of a category number that uniquely identifies a combination of said category entry and said subcategory entry, "receiving an additional specification of said category number," and "based on said receiving of said additional specification of said category number automatically reselecting said category and said subcategory in said display window," as recited in each of independent claims 9, 25, and 41.

---

[16] *Office Action* at 10.
[17] *See* MPEP § 706.07(a).
[18] *Office Action* at 3.
[19] *Linden* at Abstract.
[20] *Linden* at [0038].

Furthermore, any claim depending from an allowable independent claim is also allowable.[21] Therefore, claims 14, 15, 30, 31, 46, and 47 are patentable for the same reasons as discussed above with respect to independent claims 9, 25, and 41. Additionally, each of these dependent claims may be patentable for its own reasons. Therefore, Appellant respectfully requests that the Board reverses the rejection of claims 9, 14, 15, 25, 30, 31, 41, 46 and 47 under 35 U.S.C. § 103(a).

The Examiner rejected claims 16, 32, 48, 71, 73, and 75 under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Greef* in view *Linden*. However, claims 16, 32, 48, 71, 73, and 75 are patentable for the same reasons as discussed above with respect to independent claims 9, 25, and 41. Additionally, each of these dependent claims may be patentable for its own reasons. Accordingly, Appellant respectfully requests that the Board reverses the rejection of claims 16, 32, 48, 71, 73, and 75 under U.S.C. § 103(a).

---

[21] *See* MPEP § 2143.03.

APPEAL BRIEF UNDER 37 C.F.R. § 41.37
Serial Number 09/491,703
Filing Date: January 26, 2000
Title: METHOD AND APPARATUS FOR FACILITATING USER SELECTION OF A CATEGORY ITEM IN A TRANSACTION

Page 16
Dkt: 2043.007US1

SUMMARY

Appellant respectfully submits that the claims are in condition for allowance. As such, reversal of the rejection and allowance of the pending claims is respectfully requested.

If necessary, please charge any additional fees or credit overpayment to Deposit Account 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(408) 660-2016

Date   01/02/2013   By   /Kirt L. Iverson/

Kirt L. Iverson
Reg. No. 62,660

CLAIMS APPENDIX

9.   A method comprising:

providing a plurality of category entries to be displayed in a display window, said plurality of category entries being indicative of a categorization of a plurality of items that are available to be included in a computerized transaction;

detecting a selection of a category entry of said plurality of category entries in said display window;

in response to said detection of said selection of said category entry, providing a plurality of subcategory entries to be displayed in said display window, said plurality of subcategory entries being further indicative of said categorization of said plurality of items;

detecting a selection of a subcategory entry of said plurality of subcategory entries in said display window;

receiving a specification of a category number that uniquely identifies a combination of said category entry and said subcategory entry;

receiving an additional specification of said category number; and

based on said receiving of said additional specification of said category number automatically reselecting said category and said subcategory in said display window.

14.   The method according to claim 9, wherein said plurality of category fields are to be displayed in a first portion of said display window and said plurality of subcategory fields are to be displayed in a second portion of said display window.

15.   The method according to claim 14, wherein said first portion of said display window is substantially adjacent to said second portion of said display window.

16.   The method according to claim 14, wherein said first portion of said display window is a category field that corresponds to a page mark-up language document.

25.   A computer readable medium containing executable instructions which, when executed in a processing system, cause said system to perform a method, said method comprising:

         providing a plurality of category entries to be displayed in a display window, said plurality of category entries being indicative of a categorization of a plurality of item items that are available to be included in a computerized transaction;

         detecting a selection of a category entry of said plurality of category entries in said display window;

         in response to said detection of said selection of said category entry, providing a plurality of subcategory entries to be displayed in said display window, said plurality of subcategory entries being further indicative of said categorization of said plurality of items;

         detecting a selection of a subcategory entry of said plurality of subcategory entries in said display window;

         receiving a specification of a category number that uniquely identifies a combination of said category entry and said subcategory entry;

         receiving an additional specification of said category number; and

         based on said receiving of said additional specification of said category number.

30.   The computer readable medium according to claim 25, wherein said plurality of category fields are to be displayed in a first portion of said display window and plurality of subcategory fields are to be displayed in a second portion of said display window.

31.   The computer readable medium according to claim 30, wherein said first portion of said display window is substantially adjacent to said second portion of said display window.

32.   The computer readable medium according to claim 30, wherein said first portion of said display window is a category field that corresponds to a page mark-up language document.

41.   An article of manufacture comprising a program storage medium readable by a computer and tangibly embodying at least one program of instructions executable by said computer to perform a method, said method comprising:

providing a plurality of category entries to be displayed in a display window, said plurality of category entries being indicative of a categorization of a plurality of items that are available to be included in a computerized transaction;

detecting a selection of a category entry of said plurality of category entries in said display window;

in response to said detection of said selection of said category entry, providing a plurality of subcategory entries to be displayed in said display window, said plurality of subcategory entries being further indicative of said categorization of said plurality of items;

detecting a selection of a subcategory entry of said plurality of subcategory entries in said display window;

receiving a specification of a category number that uniquely identifies a combination of said category entry and said subcategory entry;

receiving an additional specification of said category number; and

based on said receiving of said additional specification of said category number automatically reselecting said category and said subcategory in said display window.

46.   The article of manufacture according to claim 41, wherein said plurality of category fields are to be displayed in a first portion of said display window and plurality of subcategory fields are to be displayed in a second portion of said display window.

47.   The article of manufacture according to claim 46, wherein said first portion of said display window is substantially adjacent to said second portion of said display window.

48.   The article of manufacture according to claim 46, wherein said first portion of said display window is a category field that corresponds to a page mark-up language document.

71.   The method according to claim 9, wherein said plurality of category entries and said plurality of subcategory entries are to be displayed concurrently in said display window.

73.   The computer readable medium according to claim 25, wherein said plurality of category entries and said plurality of subcategory entries are to be displayed concurrently in said display window.

75.   The article of manufacture according to claim 41, wherein said plurality of category entries and said plurality of subcategory entries are to be displayed concurrently in said display window.